

PTO/SB/21 (04-04)

Approved for use through 07/31/2006, OMB 0851-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

|  |    |                        |                           |
|--|----|------------------------|---------------------------|
|  |    | Application Number     | 10/087,142                |
|  |    | Filing Date            | March 1, 2002             |
|  |    | First Named Inventor   | Lakshmi Rambhatla, et al. |
|  |    | Art Unit               | 1632                      |
|  |    | Examiner Name          | Thai-An N. Ton            |
| Total Number of Pages in This Submission | 25 | Attorney Docket Number | 093/005P                  |

**ENCLOSURES (Check all that apply)**

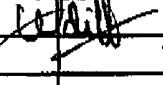
|   |  |   |
|---|--|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form (in duplicate)<br><input type="checkbox"/> Fee Attached<br><input checked="" type="checkbox"/> Amendment/Reply (18 pages)<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> (in duplicate)<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Supplemental<br><input checked="" type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> (2 pages)<br><input type="checkbox"/> Certified Copy of Priority<br><input type="checkbox"/> Document(s)<br><input type="checkbox"/> Response to Missing Parts/<br><input type="checkbox"/> Incomplete Application<br><input type="checkbox"/> Response to Missing Parts<br><input type="checkbox"/> under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a<br><input type="checkbox"/> Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br><input type="checkbox"/> Change of Correspondence Address<br><input checked="" type="checkbox"/> Terminal Disclaimer (1 page)<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Remarks | <input type="checkbox"/> After Allowance communication<br><input type="checkbox"/> to Technology Center (TC)<br><input type="checkbox"/> Appeal Communication to Board<br><input type="checkbox"/> of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC<br><input type="checkbox"/> (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please<br><input type="checkbox"/> Identify below): |
|---|--|---|

Form PTO-1449 (1 page)

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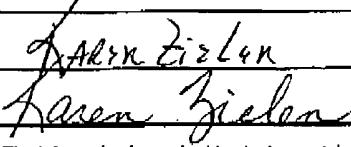
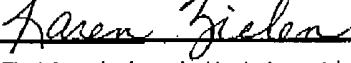
JUN 10 2004

**OFFICIAL****SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|                               |   |
|-------------------------------|---|
| Firm<br>or<br>Individual name | J. Michael Schiff, Registration No. 40,253  |
| Signature                     |  |
| Date                          | June 10/04  |

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

|                       |   |      |               |
|-----------------------|---|------|---------------|
| Typed or printed name |  |      |               |
| Signature             |  | Date | June 10, 2004 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

235

## Complete if Known

|                      |                           |
|----------------------|---------------------------|
| Application Number   | 10/087,142                |
| Filing Date          | March 1, 2002             |
| First Named Inventor | Lakshmi Rambhatla, et al. |
| Examiner Name        | Thai-An N. Ton            |
| Art Unit             | 1632                      |
| Attorney Docket No.  | 093/005P                  |

## METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money Order  Other  None

Deposit Account

Deposit Account Number 07-1139  
Deposit Account Name Geron Corporation

The Director is authorized to: (check all that apply)

Charge fee(s) indicated below  Credit any overpayments

Charge any additional fee(s) or any underpayment of fee(s)

Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description        | Fee Paid |
|----------------------------|----------------------------|------------------------|----------|
| 1001 770                   | 2001 385                   | Utility filing fee     |          |
| 1002 340                   | 2002 170                   | Design filing fee      |          |
| 1003 530                   | 2003 265                   | Plant filing fee       |          |
| 1004 770                   | 2004 385                   | Reissue filing fee     |          |
| 1005 160                   | 2005 80                    | Provisional filing fee |          |
| SUBTOTAL (1) (\$)          |                            | 0                      |          |

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims       | Independent Claims | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------------|--------------|----------------|----------|
| 20                 | -20** = 0          | 0            | X              | 0        |
| 2                  | -3** = 0           | 0            | X              | 0        |
| Multiple Dependent |                    |              |                |          |

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description  | Fee Paid |
|----------------------------|----------------------------|--|----------|
| 1202 18                    | 2202 9                     | Claims in excess of 20                                     |          |
| 1201 86                    | 2201 43                    | Independent claims in excess of 3                          |          |
| 1203 290                   | 2203 145                   | Multiple dependent claim, if not paid                      |          |
| 1204 86                    | 2204 43                    | ** Reissue independent claims over original patent         |          |
| 1205 18                    | 2205 9                     | ** Reissue claims in excess of 20 and over original patent |          |
| SUBTOTAL (2) (\$)          |                            | 0  |          |

\*\*or number previously paid, if greater; For Reissues, see above

## 3. ADDITIONAL FEES

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description  | Fee Paid |
|----------------------------|----------------------------|--|----------|
| 1051 130                   | 2051 65                    | Surcharge - late filing fee or oath  |          |
| 1052 50                    | 2052 25                    | Surcharge - late provisional filing fee or cover sheet                     |          |
| 1053 130                   | 1053 130                   | Non-English specification  |          |
| 1812 2,520                 | 1812 2,520                 | For filing a request for ex parte reexamination                            |          |
| 1804 920*                  | 1804 920*                  | Requesting publication of SIR prior to Examiner action                     |          |
| 1806 1,840*                | 1805 1,840*                | Requesting publication of SIR after Examiner action                        |          |
| 1251 110                   | 2251 55                    | Extension for reply within first month                                     |          |
| 1262 420                   | 2252 210                   | Extension for reply within second month                                    |          |
| 1253 950                   | 2253 475                   | Extension for reply within third month                                     |          |
| 1254 1,480                 | 2254 740                   | Extension for reply within fourth month                                    |          |
| 1255 2,010                 | 2255 1,005                 | Extension for reply within fifth month                                     |          |
| 1401 330                   | 2401 165                   | Notice of Appeal   |          |
| 1402 330                   | 2402 165                   | Filing a brief in support of an appeal                                     |          |
| 1403 290                   | 2403 145                   | Request for oral hearing   |          |
| 1451 1,510                 | 1451 1,510                 | Petition to institute a public use proceeding                              |          |
| 1452 110                   | 2452 55                    | Petition to revive - unavoidable   |          |
| 1453 1,330                 | 2453 665                   | Petition to revive - unintentional   |          |
| 1501 1,330                 | 2501 665                   | Utility issue fee (or reissue)   |          |
| 1502 480                   | 2602 240                   | Design issue fee   |          |
| 1503 640                   | 2503 320                   | Plant issue fee  |          |
| 1480 130                   | 1460 130                   | Petitions to the Commissioner  |          |
| 1807 50                    | 1807 50                    | Processing fee under 37 CFR 1.17(q)  |          |
| 1806 180                   | 1808 180                   | Submission of Information Disclosure Stmt                                  | 180      |
| 8021 40                    | 8021 40                    | Recording each patent assignment per property (times number of properties) |          |
| 1809 770                   | 2809 385                   | Filing a submission after final rejection (37 CFR 1.129(a))                |          |
| 1810 770                   | 2810 385                   | For each additional invention to be examined (37 CFR 1.129(b))             |          |
| 1801 770                   | 2801 385                   | Request for Continued Examination (RCE)                                    |          |
| 1802 900                   | 1802 900                   | Request for expedited examination of a design application                  | 55       |

Other fee (specify) Terminal Disclaimer

-Reduced by Basic Filing Fee Paid SUBTOTAL (3) (\$)

235

| (Complete if applicable) |                   |                  |                |
|--------------------------|-------------------|------------------|----------------|
| Name (Print/Type)        | J. Michael Schiff | Registration No. | 40,253         |
| Signature                |                   | Telephone        | (650) 473-7715 |

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0651-0232  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27.TOTAL AMOUNT OF PAYMENT (\$)  
**235**

## Complete If Known

|                      |                           |
|----------------------|---------------------------|
| Application Number   | 10/087,142                |
| Filing Date          | March 1, 2002             |
| First Named Inventor | Lakshmi Rambhatla, et al. |
| Examiner Name        | Thai-An N. Ton            |
| Art Unit             | 1632                      |
| Attorney Docket No.  | D93/005P                  |

## METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money Order  Other  None  
 Deposit Account:

Deposit Account Number  
**07-1139**  
Deposit Account Name  
**Geron Corporation**

The Director is authorized to: (check all that apply)  
 Charge fee(s) indicated below  Credit any overpayments  
 Charge any additional fee(s) or any underpayment of fee(s)  
 Charge fee(s) indicated below, except for the filing fee  
 to the above identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

| Large Entity             | Small Entity | Fee Code (\$)          | Fee Code (\$) | Fee Description | Fee Paid |
|--------------------------|--------------|------------------------|---------------|-----------------|----------|
| 1001 770                 | 2001 385     | Utility filing fee     |               |                 |          |
| 1002 340                 | 2002 170     | Design filing fee      |               |                 |          |
| 1003 530                 | 2003 265     | Plant filing fee       |               |                 |          |
| 1004 770                 | 2004 385     | Reissue filing fee     |               |                 |          |
| 1005 160                 | 2005 80      | Provisional filing fee |               |                 |          |
| <b>SUBTOTAL (1) (\$)</b> |              | <b>0</b>               |               |                 |          |

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims | Independent Claims | Multiple Dependent | Extra Claims | Fee from below | Fee Paid |
|--------------|--------------------|--------------------|--------------|----------------|----------|
| 20           | 2                  | -20 = 0            | X            | 0              | 0        |
|              |                    | -2 = 0             | X            | 0              | 0        |
|              |                    |                    |              |                |          |

| Large Entity             | Small Entity | Fee Code (\$)  | Fee Code (\$) | Fee Description | Fee Paid |
|--------------------------|--------------|--|---------------|-----------------|----------|
| 1202 18                  | 2202 9       | Claims in excess of 20                                     |               |                 |          |
| 1201 86                  | 2201 43      | Independent claims in excess of 3                          |               |                 |          |
| 1203 290                 | 2203 145     | Multiple dependent claim, if not paid                      |               |                 |          |
| 1204 86                  | 2204 43      | ** Reissue independent claims over original patent         |               |                 |          |
| 1206 18                  | 2205 9       | ** Reissue claims in excess of 20 and over original patent |               |                 |          |
| <b>SUBTOTAL (2) (\$)</b> |              | <b>0</b>   |               |                 |          |

\*or number previously paid, if greater. For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity Small Entity

| Fee Code (\$)                     | Fee Code (\$) | Fee Description  | Fee Paid         |
|-----------------------------------|---------------|--|------------------|
| 1051 130                          | 2051 65       | Surcharge - late filing fee or path  | <i>DUPLICATE</i> |
| 1052 50                           | 2052 25       | Surcharge - late provisional filing fee or cover sheet                     |                  |
| 1053 130                          | 1053 130      | Non-English specification  |                  |
| 1812 2,520                        | 1812 2,520    | For filing a request for ex parte reexamination                            |                  |
| 1804 820*                         | 1804 920*     | Requesting publication of SIR prior to Examiner action                     |                  |
| 1805 1,840*                       | 1805 1,840*   | Requesting publication of SIR after Examiner action                        |                  |
| 1251 110                          | 2251 55       | Extension for reply within first month                                     |                  |
| 1252 420                          | 2252 210      | Extension for reply within second month                                    |                  |
| 1253 850                          | 2253 475      | Extension for reply within third month                                     |                  |
| 1254 1,460                        | 2254 740      | Extension for reply within fourth month                                    |                  |
| 1266 2,010                        | 2255 1,005    | Extension for reply within fifth month                                     |                  |
| 1401 530                          | 2401 185      | Notice of Appeal   |                  |
| 1402 330                          | 2402 185      | Filing a brief in support of an appeal                                     |                  |
| 1403 290                          | 2403 145      | Request for oral hearing   |                  |
| 1461 1,610                        | 1451 1,610    | Petition to institute a public use proceeding                              |                  |
| 1452 110                          | 2452 55       | Petition to revive - unallowable   |                  |
| 1453 1,330                        | 2453 665      | Petition to revive - unintentional   |                  |
| 1501 1,330                        | 2501 665      | Utility issue fee (or reissue)   |                  |
| 1502 480                          | 2502 240      | Design issue fee   |                  |
| 1503 640                          | 2603 320      | Plant issue fee  |                  |
| 1480 130                          | 1480 130      | Petitions to the Commissioner  |                  |
| 1807 50                           | 1807 50       | Processing fee under 37 CFR 1.17(q)  |                  |
| 1808 180                          | 1808 180      | Submission of Information Disclosure Stmt                                  | 180              |
| 8021 40                           | 8021 40       | Recording each patent assignment per property (times number of properties) |                  |
| 1809 770                          | 2809 385      | Filing a submission after final rejection (37 CFR 1.128(b))                |                  |
| 1810 770                          | 2810 385      | For each additional invention to be examined (37 CFR 1.128(b))             |                  |
| 1801 770                          | 2801 385      | Request for Continued Examination (RCE)                                    |                  |
| 1802 800                          | 1802 800      | Request for expedited examination of a design application                  | 55               |
| Other fee (specify)               |               | Terminal Disclaimer  |                  |
| *Reduced by Basic Filing Fee Paid |               |  |                  |
|                                   |               | <b>SUBTOTAL (3) (\$)</b>   | <b>235</b>       |

(Complete if applicable)

|                   |                          |                                      |        |           |                  |
|-------------------|--------------------------|--------------------------------------|--------|-----------|------------------|
| Name (Print/Type) | J. Michael Schiff        | Registration No.<br>(Attorney/Agent) | 40,253 | Telephone | (650) 473-7715   |
| Signature         | <i>J. Michael Schiff</i> | Date                                 |        |           | <i>Jun 10/04</i> |

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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|   |                              |
|---|------------------------------|
| CERTIFICATE OF FACSIMILE TRANSMISSION   |                              |
| I hereby certify that this correspondence is being transmitted to the U.S. Patent & Trademark Office<br>in accordance with 37 CFR § 1.6(d) on the date indicated. |                              |
| <u>Karen Zielen</u><br>Name   | <u>June 10, 2004</u><br>Date |
| RECEIVED<br>CENTRAL FAX CENTER  |                              |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 10 2004

**OFFICIAL**

Inventors: Lakshmi Rambhatla et al.

Art Unit: 1632

Filing Date: March 1, 2002

Examiner: Tháí-An N. Ton, Ph.D.

Serial No: 10/087,142

Docket: 093/005p

Title: HEPATOCYTES FOR THERAPY AND DRUG  
SCREENING MADE FROM EMBRYONIC  
STEM CELLS

**AMENDMENT AND RESPONSE TO OFFICE ACTION  
UNDER 37 CFR § 1.111**

Commissioner for Patents  
Alexandria VA 22313

Dear Sir,

This paper is responsive to the most recent Office Action on the merits, dated April 7, 2004, for which a response is due July 7, 2004. Accordingly, this paper is timely filed.

Applicant has given careful consideration to the analysis in the Office Action. Please enter the following amendments and remarks.